

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1001.1676101

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on FEBRUARY 14, 2007

Signature 

Typed or printed name THU H. LE-TO

Application Number

10/748,933

Filed

DECEMBER 30, 2003

First Named Inventor

DAVID J. PARINS

Art Unit

3736

Examiner

RENE T. TOWA

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number 41,376



Signature

J. SCOT WICKHEM

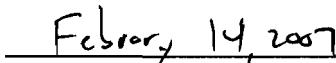
Typed or printed name

612.677.9050

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: DAVID J. PARINS et al. Confirmation No.: 1930

Serial No.: 10/748,933 Examiner: RENE T. TOWA

Filed: DECEMBER 30, 2003 Group Art Unit: 3736

Docket No.: 1001.1676101 Customer No.: 28075

Title: DISTAL ASSEMBLY FOR A MEDICAL DEVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW ATTACHMENT

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Thu H. Le-To

FEBRUARY 14, 2007

Date

Dear Sir:

Appellants submit that the Examiner's rejections contain at least the following clear errors and/or omissions of one or more essential elements needed for a *prima facie* rejection. The Examiner rejected claims 1, 3-15, 17-22, 59 and 60 under 35 U.S.C. 103(a) as being anticipated by Richardson et al., U.S. Patent No. 6,673,025 (hereinafter "Richardson"). However, to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. See MPEP §2143.03. Each and every element as set forth in the claims cannot be found in Richardson, and as such, the rejection is in error.

Claim 1 recites, in part, a core member, a tubular member with a distal end extending distally beyond the distal end of the core member, and a coil member with a distal end extending distally beyond the distal end of the tubular member.

In contrast, Richardson discloses a polymer coated guidewire, for example as shown in Figures 20 and 23. Figure 20 shows a guidewire 140 having an elongate core member 141,

a helical coil 151, a first polymer layer 156 and a second polymer layer 157. See column 19, line 65 through column 20, line 12. As illustrated below in Figure 20, the distal end of the helical coil 151 does not extend distally beyond the distal end of the first polymer layer 156.

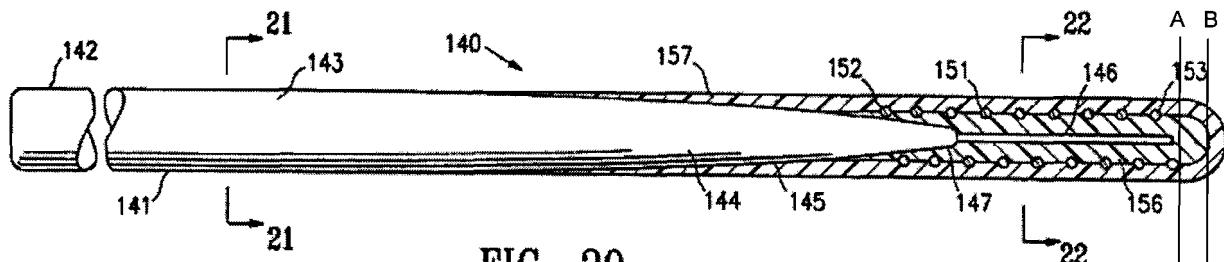


FIG. 20

In this illustrated Figure 20, lines A and B have been added. Line A shows the distal extent of the helical coil 151, and line B shows the distal extent of the first polymer layer 156. As shown in this figure by the cross-hatching marks on the first polymer layer 156, this first polymer layer 156 does extend distally to line B. In addition, the Examiner appears to agree that the first polymer layer 156 extends to line B (see page 5 of the Final Office Action).

Further, the Office Action also discusses Figure 23 of Richardson. In Figure 23, a guidewire 170 has an elongate core member 171, a helical coil 181, and a polymer layer 191. See column 20, line 59 through column 21, line 10. As illustrated below in Figure 23, the distal end of the helical coil 181 does not extend distally of the distal end of the polymer layer 191.

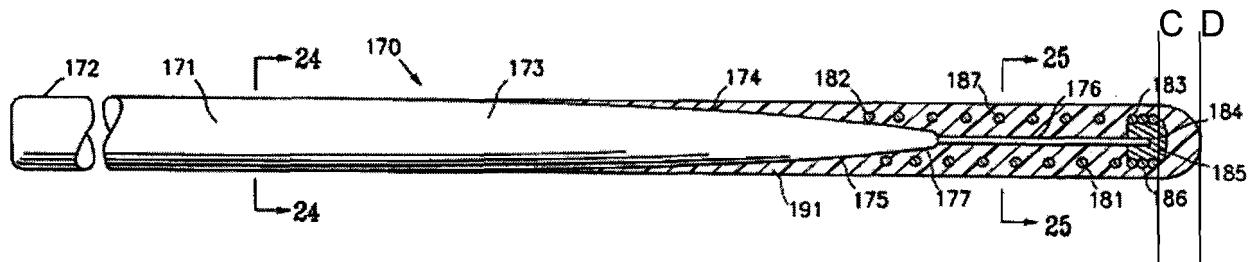


FIG. 23

In this illustrated Figure 23, lines C and D have been added. Line C shows the distal extent of the helical coil 181, and line D shows the distal extent of the polymer layer 191. As shown in this figure by the cross-hatching marks on the polymer layer 191, this first polymer layer 191 extends distally to line D.

As can be seen from the above illustrated figures, the embodiments shown in Figures 20 and 23 of Richardson are missing, at the very least, a coil member with a distal end extending distally beyond the distal end of a tubular member. However, in the Advisory Action it appears as though it is being asserted that the structure of Figure 23 could incorporate the layered structure of Figure 20, and that this would result in the structure recited in claim 1. Apparently, the Advisory Action is pointing to the general language at column 21, lines 13-18 to support the argument that Richardson discloses the use of the layered tip design in the structure shown in Figure 23.

As an initial matter, the Appellants disagree that the language at column 21, lines 13-18 of Richardson discloses such a variation of Figure 23. Specifically, this passage states: “excepting noted differences, the features, dimensions, material and any variations thereof for the various elements of guidewire 170 can be generally the same as the features, dimensions, materials and variations thereof of similar elements of guidewires 110 and 140 discussed above” (emphasis added). Appellants point out that the description of Figure 20 describes a design with two polymer layers and no weld between the distal end 153 of a helical coil 151. In contrast, the description of Figure 23 describes an entirely different tip design. The tip design of Figure 23 is described and shown as having a single layer polymer layer 191, and solder 185 formed between the distal end 184 of the helical coil 181. As such, these differences in the tip designs of Figures 20 and 23 are noted differences in the different designs of Figures 20 and 23. For this reason, the language at column 21, lines 13-18, which states that “noted differences” are not carried over between the embodiments shown in Figures 20 and 23 means that the specification of Richardson does not disclose a two polymer layer design (such as the one shown in Figure 20) being used in the embodiment of Figure 23. For at least this reason, Appellants do not believe that Richardson discloses each and every element of claim 1.

Further, even if Richardson does disclose a two polymer layer design of Figure 20 being used in the embodiment of Figure 23, such a combination would still not yield each and every element of claim 1. Specifically, the Examiner appears to be asserting that, if the two polymer layers shown in Figure 20 were placed in the embodiment of Figure 23, then the first polymer layer 156 would extend to the proximal end of the solder 185. The Examiner appears

to be asserting that, because the helical coil 181 of Figure 23 extends past the proximal end of the solder 185, this combination would have a distal end of a coil member extending distally beyond the distal end of a tubular member. However, Appellants point out that the first polymer layer in such a scenario could not be a tubular member of claim 1 in the first place. In an embodiment where the first polymer layer extends only to the proximal portion of the solder 185, the first polymer layer does not have a distal end that extends distally beyond the core member. In such a scenario, the core member, the distal extent of which extends into the solder 185, would extend distally beyond the first polymer layer, which is the opposite of what is required by claim 1. For at least this additional reason, Appellants assert that all elements of claim 1 are not disclosed in Richardson, and that this claim is allowable over this reference. Because they are dependent on claim 1 and because they contain additional patentably distinct elements, claims 3-7, 12 and 13 are also allowable over this reference.

Claim 14 recites, in part, a guidewire comprising a core member and a distal assembly. The distal assembly includes a tubular member and a coil member. The distal assembly is connected to the core member such that a portion of the distal assembly extends distally beyond the distal end of the core member. Also, the distal end of the coil member extends distally beyond the distal end of the tubular member. Claim 59 recites, in part, a medical device comprising an elongated shaft and a distal assembly, the distal assembly including a tubular member and a ribbon or wire. A portion of the distal assembly extends distally beyond the distal end of the elongated shaft, and the ribbon or wire is connected to and extending distally beyond the distal end of the tubular member.

Again, it appears as though the Examiner is using the statement at column 21, lines 13-18 of Richardson in order to support the modification of the design of Figure 23 with the 2 polymer layer design of Figure 20. As mentioned above, column 21, lines 13-18 cannot be used to modify the design of Figure 23 with the 2 polymer layer design of Figure 20 because the 2 polymer layer tip design is a noted difference between the two designs. For at least this reason, Richardson does not disclose all elements of claims 14 and 59, and these claims are allowable over this reference. Because they are dependent on claims 14 and 59, claims 15, 17, 21, 22 and 60 are also allowable over this reference.

As an additional note, claim 15 recites that a portion of the tubular member extends distally beyond the distal end of the core member. As mentioned above, even if Richardson did teach the combination of the modification of the tip design of Figure 23 with the 2 polymer layer design of Figure 20, this design would not have a tubular member that extends distally beyond the distal end of the core member as recited in claim 15. As such, all elements of claim 15 are not present in Richardson. For at least this additional reason this claim is allowable over this reference.

Claims 8, 11, 18 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson in view of Palmer et al., U.S. Patent No. 6,544,231 (hereinafter "Palmer"). Claims 9, 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson in view of Palmer further in view of Cook et al., U.S. Patent No. 5,213,111 (hereinafter "Cook"). As mentioned above, all elements of claims 1 and 14 are not disclosed in Richardson, and neither Palmer nor Cook disclose the elements that are missing from Richardson. Thus, the combinations of Richardson/Palmer and Richardson/Palmer/Cook cannot render claims 1 and 14 obvious. Because they are dependent on claims 1 and 14 and because they recite additional patentably distinct elements, claims 8-11 and 18-20 are allowable over these references.

Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,
DAVID J. PARINS et al.

By their attorney,

Date: February 14, 2007


J. Scot Wickhem, Reg. No. 41,376
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Telephone: (612) 677-9050